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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/702,611	11/07/2003	William Richard Dubrul	021016-1	8512
7590	10/01/2004		EXAMINER	
William R. Dubrul P.O. Box 246 Redwood City, CA 94064			AMERSON, LORI BAKER	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/702,611	Applicant(s) DUBRUL ET AL.	
	Examiner L. Amerson	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-9, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

2. Claims 13-14 are objected to because of the following informalities: line 4, "spring and inflatable" should read --spring or inflatable--. The examiner interprets that the element is selected from one of the springs or bag. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

a. Claims 1 and 3, 5-7 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hardee. Hardee discloses a geometric element (fig. 1) that is capable of exercising the foot of a user having a flat bottom (12) a top (16) and a coil spring element (20) between the top and bottom (fig. 1) whereby the distance

from the top to the bottom varies with the amount of force applied on the device. Regarding the language, "relatively softer than the bottom" has not been given patentable weight because the recitation is purely functional in nature and does not recite any structure. As to claims 5-7, the recitations have not been given patentable weight because the limitations are purely functional in nature and does not recite any structure. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). As to claim 12, the device is assembled from components (12, 16 and 20).

b. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Schulkin. Schulkin discloses the steps comprising choosing an exercise, selecting a device comprising a spring force element and placing the element under the body to do the exercise (col. 2, line 23).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

c. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardee as applied to claim 1 above and further in view of Naville. Hardee discloses all of the limitations of the claimed invention except for the spring

element being a loop spring. Naville teaches in figure 1 a loop spring (10,11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the coil spring for the loop spring, since a loop and coil spring is well known in the art as equivalent for their use in the exercise art and the selection of any of these known equivalents to provide compression or tension would be within the level of ordinary skill in the art.

d. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardee as applied to claim 1 above, and further in view of Mason et al. Hardee discloses all of the limitations of the claimed invention except for the spring being an inflatable bag. Thus, Mason et al teach an inflatable bag. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hardee in view of Mason et al such that an inflatable bag can be substituted as a spring element.

e. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardee as applied to claim 1 above, and further in view of de Goma. De Goma discloses all of the limitations of the claimed invention except for the device being adjustable. Thus, de Goma teaches an adjustable spring in Figure 3d. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hardee in view of de Goma such that a spring is capable of providing adjustability to vary the exercise device while in use. Regarding the language, "by adding tension to the spring" and "by adding spacers between the

coils" has not been given patentable weight because the recitations do not recite any structure.

f. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardee and de Goma as applied to claim 8 above, and further in view of Duty. Hardee and de Goma disclose all of the limitations of the claimed invention except for the tension comprising an elastic element. Thus, Duty teaches tension from an elastic element in Figure 8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hardee in view of Duty such that an elastic element is capable of providing tension to a device.

5. Claims 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 14 is allowed.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Amerson whose telephone number is (703) 306-5576. The examiner can normally be reached on Mon.-Fri from 8-5 p.m. Interviews Tue. and Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (703) 308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3764

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "L. Amerson". The signature is fluid and cursive, with a large initial "L" and a stylized "Amerson".

L. Amerson